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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* FRED S. COOK
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11 Appeal 200-000704
12 Application 09/909,445
13 Technology Center 3600
14

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16 Decided: December 9, 2009
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19 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH
20 A. FISCHETTI, *Administrative Patent Judges*.

21 FETTING, *Administrative Patent Judge*.

22
DECISION ON APPEAL

STATEMENT OF THE CASE

Fred S. Cook (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1, 2, and 4-11, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION¹

We REVERSE.

THE INVENTION

The Appellant invented a way of providing communication services from retail business locations. (Specification 2: Field of the Invention).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed July 5, 2007) and Reply Brief (“Reply Br.,” filed December 14, 2007), and the Examiner’s Answer (“Ans.,” mailed October 15, 2007).

1 1. A method for providing communication services, the method
2 comprising:
3 [a] at a retail business,
4 providing a wireless transceiver device to a customer of the
5 retail business,
6 wherein the wireless transceiver device is configured to
7 receive at least one of a plurality of different
8 communication services and
9 provide the at least one of the plurality of different
10 communication services to the customer of the
11 retail business;
12 [b] receiving in at least one location of the retail business, the
13 plurality of different communication services from a network
14 system;
15 [c] in response to providing the wireless transceiver device to
16 the customer of the retail business,
17 receiving in the at least one location of the retail business
18 a request from the wireless transceiver device
19 for the at least one of the plurality of different
20 communication services; and
21 [d] at the at least one location of the retail business,
22 processing the request for the at least one of the plurality of
23 different communication services; and
24 [e] in response to processing the request,
25 providing the at least one of the plurality of different
26 communication services
27 from the at least one location of the retail business
28 to the wireless transceiver device over a wireless
29 network.
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THE REJECTION

The Examiner relies upon the following prior art:

Reece	5,915,214	Jun. 22, 1999
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Claims 1, 2, and 4-11 stand rejected under 35 U.S.C. § 102(b) as anticipated by Reece, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Reece.

ARGUMENTS

The Appellant argue these claims as a group. Accordingly, we select claim 1, the only independent claims, as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Appellant contends that Reece does not teach or suggest: (1) receiving in the at least one location of the retail business a request from a wireless transceiver device for at least one of a plurality of different communication services; (2) processing the request; (3) providing the one of the communication services from the retail business to the transceiver device over a wireless network in response to processing the request; or (4) providing at a retail business a wireless transceiver device to a customer of the retail business. App. Br. 7-9.

ISSUES

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1, 2, and 4-11 under 35 U.S.C. § 102(b) as anticipated by Reece, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Reece turns on whether Reece describes

1 providing a wireless service from a retail business location to a customer
2 located within that retail business location, or whether it was predictable to
3 do so.

4 FACTS PERTINENT TO THE ISSUES

5 The following enumerated Findings of Fact (FF) are believed to be
6 supported by a preponderance of the evidence.

7 *Facts Related to the Prior Art*

8 *Reece*

9 01. Reece is directed to enabling a user of wireless services to
10 easily switch among various available service providers based on
11 real time cost and service feature information. Reece 1:7-12.

12 02. Reece uses a central processing facility (CPF) as a switching
13 center to route calls between wireless devices the parties called to
14 or from those devices. Reece 5:28-41.

15 03. The CPF broadcasts information regarding service from various
16 carriers in one way communication to the wireless devices. Reece
17 5:59-64.

18 04. Once a user selects a carrier based on this information, Reece
19 communicates the selection with conventional two way
20 communication. Reece 6:44-48.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." *Graham*, 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known

1 methods is likely to be obvious when it does no more than yield predictable
2 results.” *Id.* at 416.

3 ANALYSIS

4 Reece describes a process in which a user dynamically selects among
5 competing wireless carrier services. Reese provides the information upon
6 which the user decides with a one way broadcast, and the user requests a
7 particular carrier which is then provided. FF 02 - 04. Thus, contrary to the
8 Appellant’s contentions *supra*, Reece does receive a request from a wireless
9 transceiver device for at least one of a plurality of different communication
10 services, *viz.* competing carrier services; (2) process the request; (3) provide
11 the one of the communication services to the transceiver device over a
12 wireless network in response to processing the request; and (4) provide a
13 wireless transceiver device to a customer. The Appellant’s arguments focus
14 on the one way communication of Reece’s service information, without
15 acknowledging Reece’s use of two way communication for selection of a
16 service.

17 But one key element from the actual claim limitations and arguments is
18 missing from each of the four limitations just discussed, *viz.* the retail
19 business. As to the absence of Reece describing this element in the
20 limitations, we agree with the Appellant.

21 The Examiner relied upon communication between Reece’s wireless
22 devices and a central processing facility to describe the claim. Ans. 4-6. The
23 claim requires that the communication occur within the retail business
24 (limitation [3]) and that the communication to the wireless device be from
25 the retail business (limitation [5]). The Examiner has not shown Reece to

1 describe these limitations, and it is not clear why a customer would be
2 within Reece's central processing facility, which Reece does not describe as
3 being any form of retail merchant.

4 The Examiner found that Reece's description of the central processing
5 facility as being a network of smaller distributed facilities read on the retail
6 business. Ans. 6. This does not imply that even such a network would be a
7 retail business location that the customer would be located within. The
8 Examiner found that alternatively, the selection of another term in place of a
9 business facility would have been obvious. *Id.* But the test for obviousness
10 is whether the claim was obvious over the art, not whether a different claim
11 term in a limitation would have been obvious.

12 Thus, as to this element in the claim 1 limitations, we agree with the
13 Appellant that the Examiner failed to present a prima facie case.

14 CONCLUSIONS OF LAW

15 The Appellant has sustained its burden of showing that the Examiner
16 erred in rejecting claims 1, 2, and 4-11 under 35 U.S.C. § 102(b) as
17 anticipated by Reece, or in the alternative, under 35 U.S.C. § 103(a) as
18 unpatentable over Reece.

19 DECISION

20 To summarize, our decision is as follows.

- 21 • The rejection of claims 1, 2, and 4-11 under 35 U.S.C. § 102(b) as
22 anticipated by Reece, or in the alternative, under 35 U.S.C. § 103(a)
23 as unpatentable over Reece is not sustained.

REVERSED

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